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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,509	06/05/2000	Eric Ryon Peters	IOM-5973/P0445	8437

7590 05/18/2004
IOMEGA CORPORATION
10955 Vista Sorrento Parkway
San Diego, CA 92130

EXAMINER

SEAL, JAMES

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 05/18/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/587,509

Applicant(s)

PETERS ET AL. 

Examiner

James Seal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Action is in reply to applicant's correspondence of 08 March 2004.
2. Amendment to claim 1 has been entered.
3. Claims 1-3 are pending

Specification

4. The New Title has been entered and the examiner withdraws his objection.
5. Amendment to the specification (page 1, lines 14-20) has been entered and the examiner withdraws his objection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant fails to define what they mean by the word "non-removable". Do they refer to the hardware being actually removed from the computer (such that is a part of the motherboard or a chip that is soldered into the mother board or is the hardware attached to a port as a peripheral with a physical lock) or do they refer to the fact that the ID is burned into a chip so that it can not be removed by erasing or overwriting the memory. For the purpose of application of prior art, the examiner will take it to mean that it is burned into memory. The applicant points to page 7 line 24-27 for support but these lines refer to the serial numbers of the PENTIUM III processor and certainly a PENTIUM III processor is removable from the mother

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board. In any event the examiner was not able to find the word non-removable or any place in the specification where "removability" of processor chips or hardware of any kind were mention and as to what degree of effort that would define nonremovable or to what nonremovable refers to. If the applicant refers to being burned into the chip or processor then Thomas would meet that limitation.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas US 4446519 A.

9. As per claim 1, the limitation of controlling copying software is disclosed by Thomas Column 2, lines 61-66. The limitation that the computer includes a hardware ID (aka Dongle, hardware key) is disclosed lines Column 2, 64-65 as an ESD which is a plug-in circuit which contains information to identify it (the response of this device to a program which is downloaded into working memory of the computer, note the ESD response with numbers which are necessary for the program to verify this is the user's machine Column 4, lines 50-55). Thomas also mentions that in the current state of the art in which the ID is a serial number pre-stored on a circuit board are also used (Column 2, 10-14) or other number associated with or created by the software in the

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Column 3, 57-61 or Column 4, lines 40-41). The limitation of accessing the ID within the copying software and comparing it with the ID of the Hardware (and hence a hardware ID) is disclosed Column 3, 57-64. The limitation that the ID is not removable is disclosed Column 2, lines 10-14, providing the customer with a circuit board having a memory pre-stored serial number (such as in the prior art) such would then be burned into the chip or that the ESD board would be costly to copy (reverse engineer) to discover the program which would for the same reason as above have to be in a permanent memory which mean burned into the memory and hence a non-removable hardware ID. Claim 1 is rejected.

10. As per claim 2, the limitation of obtaining the hardware ID from the computer and the hard coded ID from the copying software is see claim 2 (Column 6) for computer implementation of claim 1. Claim 2 is rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas as applied to claims 1-2 above, and further in view of Schafer US5212729 A.

12. As per claim 3, Thomas is silent on the use of a user password programmed into software for software protection. Schafer teaches the inclusion of a user password with

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the software to be protected Column 5, lines 8-13. One of ordinary skill in the art at the time the invention was made would have been motivated to include the user password within the program being protected (in this case protected against copying by a third party) because the password validation would uniquely identify the user who is the legitimate user and also authorized to make copies from unauthorized third party use in this case the copying of software, that is a third party would be able to use the software provided it was run on a machine with the corresponding dongle, but not be able to copy it because they would not. Claim 3 is rejected.

THIS ACTION IS MADE FINAL.

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Seal whose telephone number is 703 308 4562.

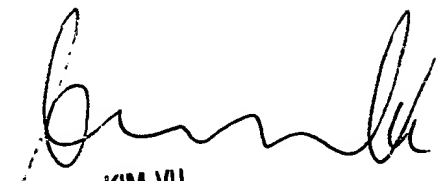
The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703 305 4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWS
Jws

May 14, 2004


KIM VU
PROBATIONARY PATENT EXAMINER
ELECTRONIC BUSINESS CENTER 2100